

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** STEVEN A. ISAAC, MARK B. GROSSMAN,  
RON E. CRITCHFIELD, MICHAEL H. TUCHEN,  
JAMES S. GWERTZMAN, and PAUL A. MCDANIEL

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Appeal No. 2001-1131  
Application No. 08/761,566

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HEARD: December 10, 2002

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Before FLEMING, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-21 and 23, which are all of the claims pending in this application.

We REVERSE.

## **BACKGROUND**

Appellants' invention relates to a customization of network documents by accessing customization information on a server computer using unique user identifiers. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of providing a network document over a network to each of multiple users of corresponding client computers, the network document for each user being customized according to predetermined user selections of the user, comprising:

during first accessing of a server computer on the network by each user client computer, obtaining customization information from the corresponding user, assigning to the customization information a unique user identifier corresponding to the user, storing the customization information in association with the unique user identifier on the server computer, and returning the unique user identifier to the client computer; and

during subsequent accessing of a selected address on the network by each user client computer, retrieving the customization information stored on the server computer by using the unique user identifier and returning to the corresponding client computer over the network a document customized according to the customization information.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Amdur, D., assc. ed. "New sites aim to personalize web navigation," INFORMATION & INTERACTIVE SERVICES REPORT, BRP Publications, Vol. 17, Issue 31, Sep. 6, 1996, pp. 1-5. (Amdur)

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Mengelbier, M., "Proposal for Extended Persistent Client State HTTP Cookies," [http://www.sbm.temple.edu/~magnus/ext\\_cookie\\_spec.html](http://www.sbm.temple.edu/~magnus/ext_cookie_spec.html), Mar. 29, 1996, (printed on Jun. 6, 1999 at 12:50 PM), pp.1-7. (Cookies Proposal)

Claims 1-21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over a public use or sale of the invention as shown by Amdur in view of Cookies Proposal. (See answer at page 4.)

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed May 19, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 15, filed Feb. 24, 2000) for appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

### **PUBLIC USE OR SALE**

The statement of the rejection is based upon 35 U.S.C. § 103, but the rejection is stated as being over a public use or sale of the invention as shown by Amdur in view of Cookies Proposal. (See answer at page 5.) We are unclear as to the examiner's basis

for the stated rejection. The use of the public use provision of 35 U.S.C. § 102(b) is a bar to patentability if the claimed invention was publically used or offered for sale more than one year before the filing of the claimed invention. The examiner maintains that Amdur evidences that there was a public usage more than one year prior to the filing of the application. (See answer at page 5.) Since the examiner has not set forth a rejection under 35 U.S.C. § 102, it is unclear if a rejection under public use or sale is set forth. We will interpret the rejection to be under 35 U.S.C. § 103 as an obvious variation of the Beta version of the Microsoft software which was publically used more than one year before the filing of the application for patent as evidenced by Amdur.

**See LaBounty Manuf. Inc. v. U.S. Int'l Trade Comm'n**, 958 F.2d 1066, 1069, 22 USPQ2d 1025, 1028 (Fed. Cir. 1992) ("Section 102(b) may create a bar to patentability either alone, if the device placed on sale is an anticipation of the later claimed invention or, in conjunction with 35 U.S.C. Section 103 (1988), if the claimed invention would have been obvious from the on sale device in conjunction with the prior art"), **see also** MPEP 2133.03.

### **35 U.S.C. § 103**

At the Oral Hearing, appellants admitted that the Beta version of the Microsoft software disclosed by Amdur was used more than one year prior to the filing of this

application, but appellants maintained that the Beta version used Cookies stored on the client computer which is different from the claimed invention and does not teach or suggest the claimed invention. Additionally, appellants denied that there was a public use of the instant claimed invention more than one year prior to the filing of the instant application. Furthermore, both declarations have additionally evaluated technical information concerning the Beta version (copy filed Dec. 20, 1999 with a release date of October 1995 for the Beta version) and found that the Beta version merely implemented the customization information using cookies stored on the client computer. (See brief at pages 6 and 7.)

Since the Beta version of the Microsoft software does not evidence non-client side storage of customization information, we must look to the teachings of Cookies Proposal. Here, we find that Cookies Proposal does not clearly teach the use of server/non-client side storage of customization information. Therefore, we agree with appellants that the public use of the Beta version of the Microsoft software in combination with the prior art teachings of Cookies proposal does not render obvious the server/non-client side storage of customization information and we cannot sustain the rejection thereof.

Appellants argue that the references disclose storing customization information of client information on a client computer, not on a server computer. (See brief at

page 5.) We agree with appellants. Appellants argue that all four independent claims recite limitations that customization information is stored on a server computer or on a computer other than the client computer. Appellants argue that Amdur teaches the use of “‘cookie’ technology, which is a small data file that holds personal user information and resides on the client hard drive. The **cookie** holds a user’s preferences.” (See brief at page 6 and Amdur at page 4.) We agree with appellants. The examiner maintains that the Amdur teaches that the Microsoft application “lets a user add favorite links directly onto the site.” (See answer at page 6 and Amdur at page 3.) We disagree with the examiner. From our review of Amdur, we find that Amdur is referring to the “Customizable Start Page site” which is discussed at page 4 as using cookies stored on the client’s hard drive to store the customization. Therefore, Amdur does not teach storage on the server or on a computer other than the client. Additionally, appellants provide two declarations which refute the examiner’s position regarding server side storage, and the examiner has not adequately rebutted these reasoned analyses of the teachings of Amdur and the Beta version of Microsoft custom home page or customized start page.

With respect to the teachings of Cookies Proposal, appellants argue that Cookies proposal teaches the storage of customization information on the client

computer and not on the server computer. (See brief at pages 9 and 10.) We agree with appellants. While the examiner maintains that the server stores the customization information, appellants' have submitted two declarations evaluating the prior art reference(s). These two declarants have determined that the disclosure of Cookies Proposal does not disclose server side storage and would not have suggested server side storage of customization information. Again, the examiner does not refute the evidence in these declarations. The examiner relies upon the second example in the overview section which teaches that a server can send back registration information and free the client from retyping a user-id on the next connection. (See answer at page 7.) From our review of Cookies Proposal, we find that the teaching of sending registration information back to the client suggests the storage of the registration information at the client rather than storage at the server. Therefore, we find that the examiner has not provided a teaching of each of the claim limitations and has not shown a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a unique user identifier to store customization information at the server or at a location other than the client. Therefore, the examiner has not established a ***prima facie*** case of obviousness, and we will not sustain the rejection of independent claims 1, 11, 17, 20, 21, and 23 and their respective dependent claims.

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### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-21 and 23 under 35 U.S.C. § 103 is reversed.

### **REVERSED**

MICHAEL R. FLEMING  
Administrative Patent Judge

JOSEPH L. DIXON  
Administrative Patent Judge

HOWARD B. BLANKENSHIP  
Administrative Patent Judge

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KLARQUIST, SPARKMAN, CAMPBELL  
LEIGH & WHINSTON  
ONE WORLD TRADE CENTER, SUITE 1600  
121 S. W. SALMON STREET  
PORTLAND OR 97204-2988